## REMARKS

Claims 1 to 10 were pending in the application at the time of examination. Claims 1 to 10 stand rejected as anticipated. Claims 1 to 10 also stand rejected for obviousness type double patenting.

Claim 1 is amended to clarify that "in said Packetized SCSI Protocol Data Out Phase" is "during transfer of said data packet information unit" in the Data Out Phase. This was inherent when the claim was read in view of the specification. For example, the Specification taught

> . . . the SCSI target asserts one of an active and an inactive data streaming signal on a line 160 of SCSI bus 150 during the transfer of a data packet information unit by initiator 110, e.g., prior to the assertion of a request signal REQ by the target device.

Specification, pg. 16, lines 2 to 7. Accordingly, the amendment does not introduce new matter and does not require consideration of new issues or a new search.

Claim 2 is amended to remove any ambiguity as to the signal on the parity line.

Claims 1 to 10 stand rejected as being anticipated by U.S. Patent No. 5,287,463, hereinafter Frame.

Applicant respectfully traverses the anticipation rejection of Claim 1 in view of Frame. The MPEP stated:

> . . . Office personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. (Emphasis in original.)

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-7, (May 2004).

The MPEP further requires:

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> Office personnel are to correlate each claim limitation to all portions of the disclosure that describe the claim limitation. This is to be done in all cases, i.e., whether or not the claimed invention is defined using means or step plus function language. The correlation step will ensure that Office personnel correctly interpret each claim limitation.
>
> The subject matter of a properly construed claim is defined by the terms that limit its scope. It is this subject matter that must be examined . . .

MPEP § 2106 C., 8th Ed., Rev. 2, p 2100-8, (May 2004).

Applicant respectfully notes that Claim 1 recites "in a Packetized SCSI Protocol Data Out phase." According to the above quotations from the MPEP, this limitation in interpreted in view of "all portions of the disclosure that describe the claim limitation."

The disclosure at page 17 lines 18 to 25 stated:

> The Packetized SCSI Protocol is well known to those of skill in the art and is described for example in "Information Technology-SCSI Parallel Interface-3 (SPI-3)," T10 Project 1302D, Rev. 13a, American National Standards Institute, New York, N.Y., January 12, 2000, which is incorporated herein by reference as an example of the level of skill in the art.

The Examiner has failed to explain where Frame teaches the Packetized SCSI Protocol Data Out Phase or where Frame teaches data packet information units transferred during that Data Out Phase according to the Packetized SCSI Protocol.

Moreover, the rejection itself demonstrates that Frame, as interpreted by the Examiner, fails to teach anything concerning the Packetized SCSI protocol. The Examiner stated in part:

> According to Frame, in order to check the integrity of the SCSI bus, the SCSI system uses byte parity for detecting data errors . . . .

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However, Frame must be interpreted in view of the level of skill in the art. The MPEP stated:

> Normally, only one reference should be used in making a rejection under 35 U.S.C. 102. However, a 35 U.S.C. 102 rejection over multiple references has been held to be proper when the extra references are cited to:
> (A) Prove the primary reference contains an "enabled disclosure;"
> (B) Explain the meaning of a term used in the primary reference; or
> (C) Show that a characteristic not disclosed in the

MPEP § 2131.01, 8th Ed., Rev. 2, pp. 2100-73 & 74 (May, 2004)

Using the qLogic reference to "explain the meaning of "Packetized SCSI," qLogic stated:

> In packetized SCSI, CRC is applied to all information units. . . **All commands and all sense information, in addition to data, are now protected against corruption by CRC.** In Ultra160 only data is protected by CRC; command and sense information have only one byte parity protection. In yet older SCSI protocols, there is no CRC protection of any sort. The uniform use of CRC in packetized SCSI represents a giant step forward in protecting data integrity. (Emphasis added.)

qLogic, § 4.1.2, pg. 11.

Since the Examiner has cited Frame as teaching using "byte parity for detecting data errors." the qLogic reference establishes that this is one of the "yet older SCSI protocols." Accordingly, the Examiner's rejection demonstrates that Frame fails to each exactly what is recited in Claim 1. For anticipation, the MPEP requires "'The identical invention must be shown in as complete detail as is contained in the ... claim.'" Thus, Frame, as interpreted by the Examiner, fails to anticipate Claim 1.

If the Examiner continues the anticipation rejection in view of Frame, the Examiner is respectfully requested to point

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out with specificity the portions of Frame that teach generating a signal as recited in Claim 1 and the data packet information unit of the Packetized SCSI protocol transferred in the Data Out Phase. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 1 in view of Frame.

The Examiner's rejection of Claims 2 and 3 further demonstrates that Frame fails to teach exactly the invention recited in Claims 2 and 3. Again the Examiner stated "the SCSI system uses byte parity for detecting data errors." Since Packetized SCSI uses CRC according to the qLogic reference, the Examiner again demonstrated that the reference fails to anticipate Claims 2 and 3. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 2 and 3 in view of Frame.

In the anticipation rejection Claim 4 contains language similar to that as discussed above for Claim 1. Therefore, the above comments concerning the anticipation rejection of Claim 1 are incorporated herein by reference. Applicant requests reconsideration and withdrawal of the anticipation rejection of Claim 4 in view of Frame.

In the anticipation rejection of Claims 5 and 7, the Examiner stated that Frame taught "monitoring a signal level on a parity line . . . in order to check the integrity of the SCSI bus, the SCSI system uses the byte parity for detecting data errors." Again, the level of skill in the art, as quoted above from the qLogic reference, demonstrates that the Examiner's interpretation is not for packetized SCSI. The entire rejection is Examiner comment without citation to Frame, and the interpretation take from Frame demonstrates that the reference teaches an older SCSI protocol and not the Packetized SCSI protocol. Applicant requests reconsideration and withdrawal of the anticipation rejection of each of Claims 5 and 7.

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Claim 6 depends from Claim 5 and so distinguishes over Frame for at least the same reasons as Claim 5. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 6 in view of Frame.

Claims 8 and 9 depend from Claim 7 and so distinguish over Frame for at least the same reasons as Claim 7. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of each of Claims 8 and 9 in view of Frame.

With respect to the anticipation rejection of Claim 10, Applicant incorporates herein by reference the above Remarks with respect to Claims 1, 5, and 7 concerning the SCSI protocol taught by Frame. Since Frame fails to teach the Packetized SCSI protocol, Frame fails to teach "'The identical invention must be shown in as complete detail as is contained in the ... claim.'" Thus, Frame, as interpreted by the Examiner, fails to anticipate Claim 10. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 10.

Claims 1 and 4 stand rejected under 35 U.S.C. 102(a) as being anticipated by "The Next Steps in SCSI" by qLogic Corp., hereinafter the qLogic reference. The Examiner stated in part:

> . . . and Data Out phase transfers command and data from the initiator to the target in the form of packet containing header and payload); and generating a signal on said SCSI bus by the SCSI target . . . to indicate whether another data packet information unit is to be accepted in the . . . Data Out phase by the SCSI target (packetized SCSI supports a plurality of packets one after another. A packet contains nexus information (for example, the unit number of the device for which the packet is intended and the type of packet or packets to immediately follow if there is one). A packet or information unit consists of a header and a payload transmitted in pairs, except when the header indicates there is no data (payload) to follow.

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Applicant respectfully traverses the anticipation rejection of Claim 1. The Examiner has cited no teaching of a target generating any signal in the Data Out phase. After the target changes the bus phase to Data Out, the packets are sent from the initiator to the target and so the extent that the Examiner considers these packets signals, the signals are generated by the initiator and not the target.

The information about the packets cited by the Examiner fails to even suggest any generation of a signal by the target in the Data Out Phase and in particular fails to teach or suggest

> . . . receiving a signal by said SCSI initiator, in said Packetized SCSI Protocol Data Out phase during transfer of said data packet information unit, . . .

as recited in Claim 1. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 1 in view of the qLogic reference.

Claim 4 depends from Claim 1 and so distinguishes over the qLogic reference for at lease the same reasons as Claim 1. Applicant respectfully requests reconsideration and withdrawal of the anticipation rejection of Claim 4 in view of the qLogic reference.

Claims 1 to 10 stand provisionally rejected under the judicially created doctrine of double patenting over claims 1 to 9 of copending Application No. 09/745,034. Applicant notes that U.S. Patent Application Serial No. 09/745, 034 issued as U.S. Patent No. 6,769, 037 B1 on July 27, 2004. Accordingly, Applicant submits herewith a Terminal Disclaimer To Obviate A Double Patenting Rejection Over a Prior Patent Including Statement Under 3.73(b) along with the required fee. Applicant respectfully submits that this renders the obviousness type double patenting rejection moot and requests withdrawal of this rejection.

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With respect to the Information Disclosure Statement, the Examiner stated:

> The Information Disclosure Statement filed 7/7/2003 has not been considered because the pending US Applications are incorrectly listed under "US Patent Documents."

Applicant respectfully notes that the Examiner has failed to cite any form paragraph and any portion of the MPEP that supports this action. Applicant respectfully points out the minimum requirements for consideration of an IDS as set forth in the MPEP. Specifically, MPEP § 609 p. 600-120 to 600-122, August 2001 states in pertinent part:

> **III. MINIMUM REQUIREMENTS FOR AN INFORMATION DISCLOSURE STATEMENT**
> ***A. Content***
>
> An information disclosure statement must comply with the provisions of 37 CFR 1.98 as to content for the information listed in the IDS to be considered by the Office. Each information disclosure statement must comply with the applicable provisions of subsection III.A(1), A(2), and A(3) below.
>
> **A (1) List of All Patents, Publications, U.S. Applications, or Other Information**
>
> Each information disclosure statement must include a list of all patents, publications, U.S. applications, or other information submitted for consideration by the Office.
>
> 37 CFR 1.98(b) requires that each item of information in an IDS be identified properly. . . . U.S. applications must be identified by the inventor, the eight digit application number (the two digit series code and the six digit serial number), and the filing date.
>
> . . . .
>
> The list of information complying with the identification requirements of 37 CFR 1.98(b) may not be incorporated into the specification of the application in which it is being supplied, but must be submitted in a separate paper. A separate list is required so that it is easy to confirm that applicant intends to submit an information disclosure statement and because it provides a readily available checklist for the examiner to indicate which identified documents have been considered. A copy of a separate list (generated by the Office) will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and

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those listed documents that have not been considered. Use of either form PTO-1449, Information Disclosure Citation, or PTO/SB/08A and 08B, Information Disclosure Statement, to list the documents is encouraged. See subsection C(2) below.

**A (2) Legible Copies**
In addition to the list of information, each information disclosure statement must also include a legible copy of:
. . . .
((C) <Each publication or that portion which caused it to be listed;

*> (D) < For each cited pending >unpublished< U.S. application, the application specification including the claims, and any drawings of the application, or that portion of the application which caused it to be listed including any claims directed to that portion; and *>

. . . .

A (3) Concise Explanation of Relevance for Non-English Language Information

Nothing in section III A(1) states that a PTO 1449 is required or that the information must be placed in a particular location on that form. In fact, it states "A copy of a separate list (generated by the Office) will also provide a simple means of communication to applicant to indicate the listed documents that have been considered and those listed documents that have not been considered." The statement is that use of PTO-1449 is encouraged. Applicant supplied a list of pending U.S. Patent Applications that included the serial number, the filing date and the inventor's name in the IDS and on the PTO-1449. Thus, Applicant complied with requirement III A(1) as quoted above, even if the Examiner ignores the submitted form PTO-1499.

A complete legible copy of each cited U.S. patent application was supplied. Thus, Applicant complied with requirement III A(2), as quoted above, Requirement III A(3) is not applicable.

Therefore, according to the MPEP, Applicant met the minimum requirements for consideration of the Information Disclosure Statement. Applicant respectfully submits that the Examiner should have considered same.

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However, to move prosecution forward, Applicant has included herein a revised PTO Form 1449 that lists the U.S. Patent Applications as "Other Documents." Applicant respectfully submits that no fee should be required because Applicant complied with the necessary requirements with the original IDS submittal. If the Examiner's disagrees, the Examiner is authorized to charge the IDS fee to the Deposit Account of Applicant's attorney, and Applicant will Petition the Commissioner for waiver of and return of the IDS fee.

Claims 1 to 10 remain in the application. Claims 1 and 2 have been amended. For the foregoing reasons, Applicant(s) respectfully request allowance of all pending claims. If the Examiner has any questions relating to the above, the Examiner is respectfully requested to telephone the undersigned Attorney for Applicant(s).

**CERTIFICATE OF MAILING**
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on **October 29, 2004**.

Attorney for Applicant(s)

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Respectfully submitted,

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